

REMARKS

Applicants present claims 1-4, 11, 23-31, 49-53, 60, 62 and 63 for examination.

The Examiner rejected each of these claims under 35 U.S.C. §103(a) as being unpatentable over Jacobsen in view of Green and further in view of Lanphere. Applicants do not concede that it would have been obvious to try to combine the references in the manner indicated by the Examiner. Nonetheless, assuming solely for the sake of discussion, that it would have been obvious to one skilled in the art to try to combine the references in the manner indicated by the Examiner, the Examiner has failed to demonstrate how the references could have been combined. Thus, the obviousness rejection is improper because the Examiner has not demonstrated that the asserted combination of Jacobsen, Greene and Lanphere would have enabled one skilled in the art to make the subject matter covered by the claims.

Applicable caselaw clearly states that “[i]n order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.” *Beakman Instruments, Inc. v. LKB Produkter AB*, 892 F2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). A claim rejection for obviousness under 35 USC §103 is improper if a person skilled in the art would not be able to make a claimed composition or perform a claimed method upon reviewing the cited prior art without undue experimentation:

[r]eferences relied upon to support a rejection under 35 USC 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. [citations omitted] An invention is not ‘possessed’ absent some known or obvious way to make it.” *In re Payne, Durden and Weiden*, 606 F2d 303, 314, 203 USPQ 245, 255 (CCPA 1979).

Under this standard, an obviousness rejection under 35 USC §103 of a composition claim is improper in “the absence of a known or obvious process for making the claimed compounds.” *In re Hoeksema*, 399 F2d 209, 274, 158 USPQ 596, 601 (CCPA 1968).

Each individual prior art reference is only presumed to be operable when it individually “expressly anticipates or makes obvious all of the elements of the claimed invention, the

reference is presumed to be operable” *See* MPEP §2121 (emphasis added). This presumption does not extend to a combination of references that requires modification of the references as a basis for an obviousness rejection. Thus, the asserted combination and modification of Jacobsen, Greene and Lanphere is not presumed to enable one skilled in the art to make purported result of the combination/modification.

It is important for the Examiner to understand that Applicants are not arguing that the references are not physically combinable (although Applicants are not conceding that the references are physically combinable). Rather, Applicants are arguing that the references do not teach one skilled in the art to make the subject matter that the Examiner alleges would result from combining the references. Hence, Applicants believe that the portions of MPEP §2145, as well as *In re Keller* and *In re Sneed*, previously cited by the Examiner are not relevant in Applicants’ argument.

Fundamentally, the Examiner has to establish that, based on the references relied upon by the Examiner, one skilled in the art would have been enabled to make the subject matter covered by the claims. The Examiner has not done this.

Neither Jacoben nor Lanphere even disclose a process for joining particles, and the processes disclosed by Greene would not work for the claimed subject matter, at least because the claimed subject matter requires the link and the at least particles to be integrally formed of the same material.

In summary, it would not have been obvious to one skilled in the art to combine the references in the manner indicated by the Examiner to provide the subject matter covered by the claims. Thus, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. §103.

The Examiner also rejected the claims under the judicially created doctrine of obviousness type double patenting. However, in view of the arguments presented above, Applicants also request reconsideration and withdrawal of this rejection.

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Respectfully submitted,

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